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THE TTAB

Paper No. 11
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Utopia Optics, LLC

Serial No. 75/599,276

Thomas P. Maloney for Utopia Optics, LLC.

Michael H. Kazazian, Trademark Examining Attorney, Law
Office 113 (Meryl Hershkowitz, Managing Attorney).

Before Simms, Cissel and Seeherman, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On Dec. 3, 1998, applicant filed the above-referenced
application to register the mark shown below,

which applicant described in its application as
"U (Stylized)," on the Principal Register for "eyeglasses
and sunglasses, and lenses, frames, and cases therefor," in
Class 9. The basis for the application was applicant's

assertion that it possessed a bona fide intention to use the mark in commerce on these goods.

The Examining Attorney refused registration under Section 2(d) of the Lanham Act on the ground that if applicant were to use the mark it seeks to register in connection with the goods specified in the application, it would so resemble four registered trademarks that confusion would be likely. He subsequently withdrew the refusal to register based on one of these registrations, but maintained the refusal to register based on the other three, all of which are owned by the same entity, Bausch & Lomb Inc., a New York corporation. The three registered marks which the Examining Attorney contends constitute bars to registration of applicant's mark are "U,"¹ "U3,"² and "U4."³ The goods identified in each of the cited registrations are "contact lenses," in Class 9.

Applicant responded to the refusal to register with argument that confusion would not be likely between the mark it seeks to register and any of the marks in the three

¹ Reg. No. 1,242,614, issued on the Principal Register on September 21, 1981; Combined affidavit under Sections 8 and 15 accepted and received

² Reg. No. 1,242,615, issued on the Principal Register on June 21, 1983; Combined affidavit under Sections 8 and 15 accepted and received.

³ Reg. No. 1,242,616, issued on the Principal Register on June 21, 1983; Combined affidavit under Sections 8 and 15 accepted and received.

cited Bausch & Lomb registrations. In addition to arguing that its stylized presentation of the letter "U" differs in appearance from the typed version of the letter "U" which the cited registered marks consist of or include, applicant stated that it had obtained a copy of the file wrapper for the Bausch & Lomb registration of the "U" mark (Reg. No. 1,242,614), and that the file shows that registration was initially refused in that case because of a prior registration of a "fanciful depiction of the letter U" in connection with "lenses, frames, mountings, and parts thereof."⁴ Applicant quoted from the argument Bausch & Lomb made to the Examining Attorney in that application against the refusal to register. Based on the record in that case, applicant herein contended that the Examining Attorney there must have concluded that contact lenses and frames and ophthalmic lenses do not travel in the same channels of trade, and that this fact, combined with the distinctions between the registered fanciful "U" in that case and the "U" that Bausch & Lomb sought to register there were

⁴ Reg. No. 786,394, issued to Univis, Inc. on March 9, 1965. Although a copy of this registration was not submitted by applicant until the filing of its brief, and therefore was not timely submitted under Trademark Rule 2.142(d) of the Trademark Rules of Practice, we have considered it because the Examining Attorney treated it as if it were of record.

sufficient to make confusion unlikely.

The Examining Attorney in the instant case was not persuaded by applicant's arguments, however, and in his second Office Action, he made the refusal to register final based on his conclusions that applicant's mark is virtually identical to one of the cited registered marks and quite similar to the other two, and that eyeglasses, sunglasses, lenses, frames and cases for them are closely related to contact lenses.

In support of this conclusion, he submitted copies of many third-party registrations which list both contact lenses and eyeglasses as the goods in connection with which the marks are registered, along with excerpts retrieved from the Nexis database of published articles. The excerpts state that Bausch & Lomb makes both eyeglasses and contact lenses, and that eyeglasses and contact lenses are sold to the public by ophthalmologists and optometrists, as well as to licensed eyecare professionals over the Internet.

Applicant timely filed a Notice of Appeal and an appeal brief. The Examining Attorney filed his brief on appeal, and applicant filed a reply brief, but no oral hearing before the Board was requested.

Based on careful consideration of the record and arguments before us, we find that the refusal to register is well taken.

In the case of *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), the predecessor to our primary reviewing court set out the factors to be considered in determining whether confusion is likely. Chief among these factors are the similarity of the marks as to appearance, pronunciation, meaning and commercial impression, and the similarity of the goods as set forth in the application and registration, respectively.

In the case at hand, the record shows that the goods set forth in the application are closely related to the goods listed in the cited registrations, and the mark applicant seeks to register is virtually identical to one of the cited registered marks, "U," and creates a commercial impression which is similar to those engendered by the other two cited registered marks, "U3" and "U4," so use of applicant's mark in connection with such related products would be likely to cause confusion.

Turning first to consideration of the relatedness of the goods in the registrations and the goods identified in the application, although some of the third-party registrations submitted by the Examining Attorney were

registered under Section 44 of the Act, many are based on use in commerce. These registrations, which list both contact lenses and eyeglasses, tend to show that these goods may emanate from a single source. In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993); In re Mucky Duck Co., 6 USPQ2d 1467 (TTAB 1988). The excerpt from the interview with registrant's Chief Executive Officer which was provided by the Examining Attorney indicates that the public has been exposed to the notion that the owner of the cited registration manufactures both contact lenses and eyeglasses. The other excerpted articles indicate similar exposure to the idea that optometrists and ophthalmologists dispense both contact lenses and eyeglasses, and that both products are sold to such eyecare professionals over the Internet for subsequent resale to the public. Contact lenses and eyeglasses obviously are used by the same people, ordinary consumers, for the same purpose, to correct vision. The goods set forth in the application are closely related to the goods identified in the cited registrations.

Applicant's contention that the arguments made by the owner of the cited registration in its application to register the cited "U" mark are binding on the Patent and Trademark Office in the instant case is not well taken for

several reasons. In this proceeding, which is an ex parte appeal from the refusal to register the mark of Utopia Optics LLP, Bausch & Lomb's argument in another application with respect to another, different, stylized "U," which was registered to an entity unrelated either the applicant in the instant proceeding or to Bausch & Lomb, plainly does not have the effect, as argued by applicant, of somehow constituting an estoppel against Bausch & Lomb, which is also not a party to this proceeding. The propriety of the registration of the cited mark is not before us in this appeal. It is well settled that the Board is not bound by prior decisions of Examining Attorneys to register other marks, and that each case before us must be resolved on its own record and merits. In re Nett Designs, Inc., 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).

In the instant case, notwithstanding applicant's argument to the contrary, applicant's mark, which is a stylized letter "U," is virtually the same as the registered mark "U." Although applicant's mark is presented in special form, the stylization is not so distinctive as to create a commercial impression which is substantially different from that created by the typed version of the letter in the cited registration, such that purchasers are likely to believe that the goods bearing the

two marks come from a different source. Moreover, as pointed out by the Examining Attorney, the protection accorded to a mark registered in typed form extends to all reasonable depictions of that mark, and in this case, would include a presentation of the letter "U" in the style in which applicant intends to use it. *Plus Products v. Vita Plus, Inc.*, 220 USPQ 922 (TTAB 1983).

In view of the close similarity between the registered mark "U" and the mark applicant seeks to register, their use on the closely related goods set forth in the registration and application, respectively, would be likely to cause confusion.

Applicant's stylized "U" is also similar to the other two registered marks, "U3" and "U4," cited as bars to registration. Although the registered marks also contain the numbers "3" and "4," when the marks are considered in their entireties, applicant's mark and the cited marks create similar commercial impressions. The numbers would likely be understood as indications of different models, or as indications of different features, of "U" brand contact lenses. In view of the established relationship between the goods in these registrations and the goods set forth in the application and the similarities between these marks

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and the mark applicant seeks to register, confusion would be likely.

Decision: The refusals to register under Section 2(d) are affirmed.

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